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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/056,940 | 01/25/2002 | David N. Schissel | SP01-136 | 2302 |

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3
EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/056,940

Applicant(s)

SCHISSEL ET AL.

Examiner

Jill M. Gray

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

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DETAILED ACTION

Remarks

The preamble of claims 59-62 is inconsistent with independent claim 54. The suggested language is "[t]he method"

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-24, 43-53, and 60-78 are rejected under 35 U.S.C. 102(a) as being anticipated by International Publication WO 01/05724 A2 (hereinafter the publication).

The publication teaches a radiation curable resin composition and optical fiber coated therewith. The coating is of the type contemplated by applicants comprising a (meth)acrylate urethane compound having a molecular weight within applicants' range and a Tg of less than about -30°C , as required by claims 1, 5-7, 21, 43 and 47-49. Regarding claims 2 and 44, the publication teaches that mixtures of the urethane compound can be used. As to claims 3-4, 19, 24, and 45-46, since the prior art teaches the same compound as applicants' the "m" and "n" values necessarily would be the same. See page 3, line 30 through page 4, and line 14. As to claims 8-9, and 50-51, the publication teaches that the coating includes a monomer having a functional group such as methacrylates, acrylamides and acrylate. See page 14, line 6 through page 17.

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Regarding claims 10-13, 18, 20, 22, and 52-53, the publication teaches that the cured coatings can have a Young's modulus as low as 0.1 Mpa and an elongation-at-break of preferably at least 110%, further teaching a tensile strength that is at least 50% of the modulus. See pages 22, 23, and 28. In addition, the publication teaches a method of making said urethane compound that is essentially as claimed in claims 70-76. See page 7, line 16 through page 8, and line 4. Further teaching a method of making an optical fiber coating essentially as claimed by applicants in claims 60-69 (note page 18 teaches adding a photoinitiator). As to the micro-bend attenuation set forth in claims 14-17 and 77-78, because the prior art teaches a radiation curable coating that is substantially the same as applicants, this property would necessarily be the same as applicants and is inherent.

Therefore, the prior art teachings in the publication anticipate the invention as claimed in the present claims.

3. Claims 1-9, 25-51, and 54-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamazaki et al, European Patent Publication EP 0874,012 A1 and 6,057,034 (hereinafter referred to collectively as Yamazaki).

Yamazaki teaches a coating composition and optical fiber coated therewith wherein said optical fiber is coated with a composition comprising a polyurethane (meth)acrylate oligomer as required by claims 1-6, 25-27, 33-36, 43-48, 55-58, and 68. See abstracts. In addition, Yamazaki teaches that a monomer having functional groups such as (meth)acrylates and acrylates can be added, as required by claims 8-9, 28-30, 34, 36, 50-51, 63-67, and 69. See '034, column 7, line 39 through column 8. As to

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claim 32, Yamazaki teaches amounts within applicants' range. See '034, column 6, lines 4-7. Regarding claims 54-58, Yamakazki teaches a method of coating an optical fiber comprising drawing a glass fiber and coating with a radiation curable coating (column 1, lines 41-44), further teaching irradiating (column 16, lines 13-21). As to claims 63-74, Yamakazki teaches in the examples a method of making an optical fiber coating and method of making an oligomer, wherein each method is essentially as that claimed by applicants. As to the T_g and micro-bend attenuation as claimed in claims 7, 31, 39-42, 49, 59-62, and 75-78, it is the examiner's position that since the composition of the prior art is the same as applicants then all properties are the same as well and thus are inherent.

Therefore, the prior art teachings of Yamakazki anticipate the invention as claimed in claims 1-9, 25-36, 39-51, and 54-78.

No claims are allowed.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 703.308.2381. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703.872.9310 for regular communications and 703.872.9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.


Jill M. Gray
Examiner
Art Unit 1774

jmg
June 30, 2003